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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/078,808

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Manas Kumar Majumdar

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7590

06/23/2006

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EXAMINER

WOODWARD, CHERIE MICHELLE

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/078,808

Applicant(s)

MAJUMDAR ET AL.

Examiner

Cherie M. Woodward

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21,23-29 and 31-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 23-29 and 31-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Formal Matters***

1. Applicant's Reply and Amendments, filed 10 April 2006, are acknowledged. Claims 21, 23-29, and 31-37 are pending and under examination.

***Response to Arguments***

***Claim Objections/Rejections Withdrawn***

2. The rejection of claims 23, 24, 28-29, 32-33, 35, and 36, under 35 U.S.C. 1 12, first paragraph, scope of enablement, is withdrawn in light of Applicant's Amendments, filed 10 April 2006.
3. The rejection of claims 23, 24, 28-29, 32-33, 35, and 36 under 35 U.S.C. 1 12, first paragraph, written description, is withdrawn in light of Applicant's Amendments, filed 10 April 2006.
4. The rejection of claims 21, 23-24, 26-28, 32-33, and 35-36 under 35 U.S.C. 102(e) as being anticipated by Goldberg *et al.*, (US 2002/0110544, issued as U.S. Patent 6,835,377) is withdrawn in light of Applicant's Amendments, filed 10 April 2006.
5. The rejection of claims 21, 23-29, and 31-37 under 35 U.S.C. 103(a) as being unpatentable over Goldberg *et al.*, (US 2002/0110544, issued as U.S. Patent 6,835,377), in view of Barbara *et al.*, (JBC 8 January 1999 274(2):584-594), is withdrawn in light of Applicant's Amendments, filed 10 April 2006.

***Claim Objections/Rejections Maintained – 35 USC 102(e)***

6. The rejection of claims 21, 23-29, and 31-37 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,761,887 (Kavalkovich *et al.*, PCT Pub WO 00/29552, (the '887 patent)) is maintained for the reasons of record and for the reasons stated herein.

Applicant's argue that the '887 patent is not available under 102(e) as prior art because it is a patent that issued from an international application filed before 29 November 2000, where the prior art (35 USC 371 date is 21 June 2001, which is later than the present application's earliest priority date of 23 February 2001. Applicant's argument is acknowledged, but is not persuasive.

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The Examiner is aware the '887 patent is a 35 USC 371 filing of an international application with a PCT filing date of 16 November 1999 and a 35 USC 371 date of 21 June 2001. The PCT publication date of 25 May 2000 is also prior to 29 November 2000, thus prohibiting the PCT publication from being a "deemed" publication. Additionally, for the purposes of examination, the benefit date of the provisional application No. 60/180,594, filed 16 November 1998, is also unavailable.

However, in the instant case, there are two provisional applications to which Applicants claim benefit of the earlier filing date. The first one, 60/271,186, filed 23 February 2001 does not teach non-tissue culture expanded CD105+ cells. Instead, it teaches isolation and culture expansion of mononuclear cells derived from bone marrow. The second provisional application to which benefit is claimed is 60/333,975, filed 29 November 2001. The '975 provisional does teach isolated bone marrow cells, including CD105+ cells that are non-tissue culture expanded (see i.e. p. 9 and p. 15). As such, benefit in the instant case may only be granted to the 60/333,975 provisional with a filing date of 29 November 2001. Because the earliest available benefit date for the instant application is 29 November 2001 and the 35 USC 371 date of the '887 patent is 21 June 2001, the '887 patent is available as prior art under 102(e).

***Requirement for Priority Showing Under 37 CFR 41.202(d)(1)***

7. Instant claims 21, 23, 36, 27, 28, 32 and 35 render obvious and are rendered obvious by claim 6 of the '887 patent (supra). Instant claims 24, 25, 29, 31, 33, 34, 36, and 37 render obvious and are rendered obvious by claim 7 of the '887 patent. Non-tissue culture expanded CD105+ cells are taught at column 5, lines 25-46 of the '887 patent. The instant claims contain the same subject matter as the '887 patent and are directed to the same invention

Whenever an application has an earliest constructive reduction-to-practice that is later than the earliest constructive reduction-to-practice of a patent with which it interferes, the applicant must make a priority showing under 37 CFR 41.202(d)(1). The Applicant may file a showing to overcome a rejection based on 102(e) when an affidavit is not permitted under 37 CFR 1.131(a)(1) because the applicant is claiming interfering subject matter. If no showing has been filed, and the application's earliest constructive reduction-to-practice date is later than the earliest constructive reduction-to-practice of a patent, then the examiner must require a showing of priority. This showing is necessary because an insufficient showing (including no showing at all) can trigger a prompt judgment against the applicant in an interference (see 37 CFR 41.202(d)(2)). See also MPEP 2305.

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An applicant presenting a priority showing must establish through the showing that it would prevail on priority if an interference is declared and the opponent does not oppose the showing. The requirement for a priority showing is intended to spare a senior party patentee the burden of an interference if the junior party applicant cannot establish that it would prevail in an interference even if the senior party does nothing. *Kistler v. Weber*, 412 F.2d 280, 283-85, 162 USPQ 214, 217-19 (CCPA 1969) and *Edwards v. Strazzabosco*, 58 USPQ2d 1836 (Bd. Pat. App. & Inter. 2001).

The consequence of an inadequate showing may be serious for the applicant. If an interference is declared and the Board of Patent Appeals and Interferences (Board) finds the priority showing insufficient (thereby issuing an order to show cause why judgments should not be entered against the applicant), the application will not be allowed to present additional evidence to make out a priority showing unless the applicant can show good cause why any additional evidence was not presented in the first instance with the priority showing before the examiner. 37 CFR 41.202(d)(2); *Huston v. Ladner*, 973 F.2d 1564, 23 USPQ2d 1910 (Fed Cir 1992); *Hahn v. Wong*, 892 F.2d 1028, 13 USPQ2d 1313 (Fed Cir 1989); *Edwards v. Strazzabosco*, 50 USPQ2d 1836 (Bd. Pat. App. & Inter. 2001). The principles which govern review of a priority showing are discussed in *Basmadjian v. Landry*, 54 USPQ2d 1617 (Bd. Pat. App. And Inter. 1997) (citing former 37 CFR 1.608(b)).

### *Conclusion*

**NO CLAIM IS ALLOWED.**

**Due to the Requirement for Priority Showing, this action is Non-Final.**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cherie M. Woodward whose telephone number is (571) 272-3329. The examiner can normally be reached on Monday - Thursday 9:00am-7:30pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CMW

  
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